



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,204	12/22/1999	SATOSHI NISHIKAWA	862.3177	5888

5514 7590 07/26/2005

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
----------	--------------

2624

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/470,204	<b>Applicant(s)</b> NISHIKAWA ET AL.	
	<b>Examiner</b> Thierry L. Pham	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3,5,8,9 and 11 is/are allowed.
- 6) ☒ Claim(s) 1,4,6,7,10 and 12-22 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 4/26/05.
- Claims 1-22 are pending in application.
- Claims 3 & 9 were objected under 37 CFR 1.75 in previous office action has been withdrawn.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6-7, 10, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young (U.S. 5749024), and in view of Shima et al (U.S. 6104498), and further in view of Matysek et al (U.S. 5442732).

Regarding claim 7, Young discloses a printing control apparatus (printer controller #100, Fig. 1, col. 4, lines 1-28) for controlling a printing device to output printing data onto a printing medium, comprising:

- separation printing check means (checks via printer controller 100, fig. 1, col. 1, lines 65-67 to col. 2, lines 1-12 and col. 4, lines 45-60) for checking a separating separation printing setting, representing whether a predetermined medium (paper sheet, col. 2, lines 30-67) is additionally output over each page of the output printing data result (transparency, col. 2, lines 30-67);
- printing order check means (printing order control system, col. 2, lines 30-67) for checking a printing order setting, set in advance, representing whether the printing data is output from a final page or from a first page (face-up, from page 1 to pages N, or face-down, from pages N to page 1) printing, col. 2, lines 30-67);
- control means (output modules, col. 2, lines 1-10) for selectively controlling to (i) output each page of the printing data and then output the predetermined medium before a next printed page is output when the separation printing setting is set to additionally output the predetermined

medium and the printing order setting is set to output (transparency than paper sheet if printing face-down, abstract and col. 2, lines 30-67 and col. 5, lines 5-17), and (ii) output the predetermined medium before each page of the printing data is output when the separation printing setting is set to output the predetermined medium and the printing order setting is set to output the printing data from the final page (paper sheet than transparency if printing face-up, abstract and col. 2, lines 30-67 and col. 5, lines 5-17); and

- wherein the printing setting means sets the separation printing setting and the printing order setting with respect to individual print jobs (the printing can be set with respect to individual print jobs by interchanging an attachment of a different output module or printer controller 100 of fig. 1, col. 1, lines 65-67 to col. 2, lines 1-10 and col. 3, lines 35-42).

However, Young fails to explicitly disclose a controller for controlling a printer from a host computer and a printing setting based on a user input to a paper feeding setting screen for setting printing order provided by a printer driver.

Shima, in the same field of endeavor for printing, teaches a controller for controlling a printer from a host computer (host computer 42, fig. 3) and a printing setting based on a user input to a paper feeding setting screen for setting printing order provided by a printer driver (host computer 42 includes a printer driver for setting a print order such as face up or face down printing, fig. 3, col. 4, lines 32-50 and col. 8, lines 42-62).

The combinations of Shima and Young fail to explicitly teach a printer driver user interface, which allows user to select a separation printing setting.

Matysek, in the same field of endeavor for printing, teaches a printer driver user interface, which allows user to select a separation printing setting (printer driver user interface as shown in figs. 4 allows users to select interleave paper between transparencies and many other finishing options controlled remotely via a host computer or workstations, col. 6, lines 42-62 and col. 8, lines 65-67+).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Young, Shima, and Matysek because of a following reason: (●) to allow users/operators to control printer's capabilities remotely, i.e., face-up or face-down printing order; by doing so, it will increase operating efficiency and to reduce human intervention; (●) interleave blank papers between transparencies to prevent transparencies from sticking together.

Therefore, it would have been obvious to combine Young, Shima, and Matysek to obtain the invention as specified in claim 7.

Regarding claim 10, Young further discloses the apparatus according to claim 7, wherein the printing medium is a transparent resin film, and the predetermined medium is paper (transparency and paper sheet, Abstract and col. 5, lines 10-15).

Regarding claim 12, Young further discloses the apparatus according to claim 7, further comprising spool means for converting the predetermined data into another format and saving the converted data as a spool file (it is known in the art that print data are converted to a printer format/languages before printing, i.e., PDL, PCL, and/or raster data. Such conversion can be done by printer driver); and de-spooler means for mapping the spool file under control of said control means and supplying the mapped file to the printing device (also see Shima for further information regarding language interpretation and spooling means as shown in fig. 10).

Regarding claims 1, 4, and 6: Claims 1, 4, and 6 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 7, 10, and 12; therefore, claims 1, 4, and 6 are rejected for the same rejection rationale/basis as described in claims 7, 10, and 12 above.

Regarding claim 13: Claim 13 recites limitations that are similar and in the same scope of invention as to those in claim 1 and 7 except computer readable memory for storing computer programs. All computers/printers have some type of computer readable medium (i.e. RAM, Fig. 3, Shima) for storing computer programs, hence claim 13 would be rejected using the same rationale as in claims 1 and 7.

Claims 14-19 recites limitations that are similar and/or correspond to claims 1, 4, 7, and 10 as described above; therefore, the methods and/or apparatus claims recited (14-19) are included by the operation of the apparatus claim as described above (claims 7 & 10). Please see rejection basis/rationale as described in claims 7 & 10 above.

Claims 20-22 recites limitations that are similar and corresponds to claims 7 & 10 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers/printers have some type of computer readable memory medium for storing computer programs, hence claim 20-22 would be rejected using the same rationale as in claims 7 & 10.

**NOTE: Claims 14-22 include broader limitations and such limitations are covered by claims 1, 4, 7, and 10. Please see those claims for more details.**

### ***Response to Arguments***

Applicant's arguments filed 4/26/05 have been fully considered but they are not persuasive.

- Regarding claims 1, 4, 6, 7, 10, and 12-22, the applicant argued the cited prior arts of record fail to teach and/or suggest “setting a separation printing setting and a printing order setting representing whether the printing data is output from a final page or from a first page based on a user input to a paper feed setting screen of a graphical user interface provided by a printer driver”.

In response, the applicants argued subject matter that were not previously cited in claims 1, 4, 6, 7, 10, and 12-22. Nowhere within any previous pending claims including features “based on a user input to a paper feed setting screen”. However, upon further consideration of previous cited prior arts of record, Shima teaches a controller for controlling a printer from a host computer (host computer 42, fig. 3) and a printing setting based on a user input to a paper feeding setting screen for setting printing order provided by a printer driver (host computer 42 includes a printer driver for setting a print order such as face up or face down printing, fig. 3, col. 4, lines 32-50 and col. 8, lines 42-62, paper feeding setting screen is also performed via using printer driver provided by the host computer 42).

Art Unit: 2624

Applicant's arguments, see pages 15-16, filed 4/26/05, with respect to claims 2-3, and 8-9 have been fully considered and are persuasive. The rejection of claims 2-3, and 8-9 has been withdrawn.

### *Allowable Subject Matter*

- Claims 2-3, 5, 8-9, and 11 are allowed.
- The following is a statement of reasons for the indication of allowable subject matter:

The cited prior arts of record (US 5749024, US 6104498, US 5442732, and US 5282050) fail to teach and/or suggest a printing control method and/or apparatus of controlling, from a host computer, a printing device to output printing data onto a printing medium comprising:

- a saving state check step of checking whether the printing device is set to a saving state in which a page having no output data is not output; and
- a saving function invalidating step of invalidating setting of the saving state when setting of additionally outputting the predetermined medium is detected in the separation printing check and setting of the saving state is detected in the saving check step.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

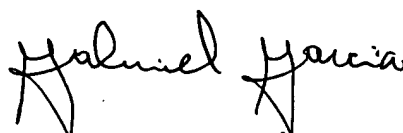
Art Unit: 2624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA  
PRIMARY EXAMINER